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| 27496 | 7590 | 12/02/2005 | EXAMINER | |
| PILLSBURY WINTHROP SHAW PITTMAN LLP | | | FISCHER, ANDREW J | |
| 725 S. FIGUEROA STREET | | | ART UNIT | |
| SUITE 2800 | | | PAPER NUMBER | |
| LOS ANGELES, CA 90017 | | | 3627 | |

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,494

Applicant(s)

PIERCY ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Applicants' amendment filed September 8, 2005 is acknowledged. Accordingly, claims 30-45 remain pending.
2. This Office Action, the "First Final Office Action" is given Paper No. 20051125.
3. All references in this Office Action to the capitalized versions of "Applicants" refers specifically the Applicants of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
4. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §112 2nd Paragraph

5. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 30-33 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. Claim 30 is indefinite because it is unclear if the computer program will "adjust the inventory projection to meet the target inventory" if there is *not* "a difference between

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the target inventory for the next processing day and the inventory projection for the current day.” In other words, if the condition is *not* met, what is the scope of the claim?

Applicants are reminded that, “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if *any* of the structures or compositions within the scope of the claim is known in the prior art. [Emphasis added.]” *Brown v. 3M*, 265 F.3d 1349, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (citations omitted). Because Applicants recite two possible alternatives in claim 30 (*i.e.* the “if” condition *is* met, or alternatively, the “if” condition is *not* met), the Examiner elects for anticipation/obviousness purposes the alternative choice of when the “if” condition is *not* met. Thus, although the phrase “adjust the inventory projection to meet the target inventory for the next processing day by creating an adjusted inventory projection” has been considered, the phrase however is not entitled to patentable weight.

7. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC §103

8. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 30-45, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Ayala et. al. (U.S. 2003/0018516 A1)(“Ayala”) in view of White’s How Computer’s Work Millennium. Ed. (“White”), Greene’s Production & Inventory Control Handbook (“Greene”), Dobler’s Supply Chain Management (“Dobler”), and Chopra’s Supply Chain Management (“Chopra”). In this rejection, the additional references are provided to show that which is old and well known in the art. See §MPEP 2131.01 expressly authorizing additional references to show features that are either inherent or old and well known in the art. Ayala discloses the claimed invention including receiving supply line information (this includes put is not limited to forecast information, price, availability, etc); generating an inventory projection for a plurality of days based on the supply line information (step 210, ideally the projection information is equal to the demand information, *i.e.*, if 5 widgets are needed, then the maker hopes to produce 5 widgets); the “plurality of days” is the maximum possible forecast window of the computer system; determining a calculation window within the plurality of days (*i.e.* pick a forecast window which is less than the maximum possible window- this will virtually always occur); verify that a next processing day is within the calculation window (the “next processing day is the next plant day for plants that operate *e.g.* only 5 or 6 days per week, thus the day off is not counted in the forecast window); minimum inventory (safety stocks); maximum inventory (lot size of dependent inventory ordered); compare the target inventory (what you *intend* to produce) with the inventory projection (what you *want* to produce) and adjust the reports accordingly (this might occur if *e.g.* dependent inventory had transportation problems due to bad

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weather). It is the Examiner's position that Ayala does not directly disclose precisely as claimed "the next processing day." Both Green and Dobler teach, *inter alia*, that manufacturing plants need not necessarily operate 7 days a week and therefore all facets of planning must account for *x* days off in their respective schedules. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Ayala as taught by Green and/or Dobler to the old and well known features of Greene and/or Dobler such as planning for various days off. Such a modification would have help account for plants that stop production during holidays, Sundays, or other days off. Moreover, the automation would have helped increase profits. See *e.g.* Bragg.

10. In this particular rejection, White is cited simply to show those features that are—to one of ordinary skill in this art—either inherent or old and well known in a computer. Such features include but are not limited to: a hard drive, and random access memory ("RAM"), see *e.g.* White, pp 12-13 and Chapter 11, "How RAM Works."

11. In this particular rejection, Greene is also cited to show those features that—to one of ordinary skill in this art—are old and well known in a computerized inventory system. Such features include but are not limited to: attributes of the inventory in an inventory database, see Table 30.4; control attributes in the inventory database, see Table 30.5; safety stocks (pp 11.16, 18.4, 19.2, and 19.9); customer order attributes that would be found in a customer order table, see Table 30.6; a material requirements plan ("MRP") for the product(s), see Tables 11.3 to 11.7; distribution requirements planning ("DRP"), See "Distribution Requirements Planning," pp 11.40-11.42; and Master Production Schedules, see pp 12.1-12.49.

12. In this particular rejection, Dobler and Chopra is also cited to show those features that—to one of ordinary skill in this art—are old and well known in a computerized inventory system.

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Such features include but are not limited to: the fundamentals of production planning, Dobler: pp, 492-494; material management activities, Part 6 including Inventory Management, Chapter 23; and developing and managing the buying plan, Chapter 27; Chopra: at least Chapters 1, 8, & 12.

13. Because Applicants have not objectively indicated and redefined claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner concludes that Applicants have decided not to be their own lexicographer. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,¹ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements² with the required clarity, deliberateness, and precision.³ Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not

¹ See the Examiner's First Non Final Office Action, mailed May 4, 2005, Paper No. 05012005, Paragraph No. 24 which begins on page 9.

² "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

³ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

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invoked,⁴ Applicants have not pointed out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants have not argued lexicography is invoked). Finally and to be sure of Applicants’ intent, the Examiner also notes that Applicants have declined the Examiner’s express invitation⁵ to be their own lexicographer.⁶ It remains the Examiner’s position that these requirements were reasonable.⁷ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁸ The Examiner now

⁴ See again the First Non Final Office Action, Paragraph No. 24.

⁵ *Id.*

⁶ See e.g. *Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants’ failure to correct the examiner’s characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner’s express invitation to correct a possible error in claim interpretation: “applicant’s attention was called to the examiner’s interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner’s interpretation—an invitation the applicant did not accept.”).

⁷ The Examiner’s requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner’s requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed November 25, 2005).

⁸ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim

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relies heavily and extensively on this interpretation.⁹ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

14. Under the broadest reasonable interpretation standard noted above and unless expressly modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary¹⁰) during ex parte examination.

15. Even though Applicants have now presented new claims 30-45, the Examiner again maintains his position that the new claims do not contain any product-by-process limitations. See the First Non Final Office Action, Paper No. 05012005, Paragraph No. 28, beginning on page

14. Because the Examiner will continue with this presumption as long as the claims remain directed to a product, this issue will not be further addressed by the Examiner.

language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

⁹ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . [Emphasis added.]"

¹⁰ See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").

Response to Arguments

16. Applicants' arguments filed September 8, 2005 have been fully considered. Applicants have overcome the §101 rejections because Applicants now recite a product. "When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim." MPEP §2106 IV B. 1 (a) (last paragraph).

17. Applicants' remaining arguments have been considered but they are not persuasive.

Conclusion

18. Applicants' amendment filed September 8, 2005 necessitated the new grounds of rejection presented in this First Final Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

19. References considered pertinent to Applicants' disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

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20. The following three (3) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8th Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100, 1500, 2000, 2500, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8th Edition, August 2001.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22. Applicants are reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) ("patents are written by and for skilled artisans"). The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner's position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicants are hereby given actual notice that if after reasonably reading any reference of record, if Applicants can not reasonably

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understand or if Applicants have difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in one or more of the reference(s) of record, Applicants should (in their next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicants' response must also state *why* they either do not understand or have difficulty comprehending the reference. If after properly receiving (*i.e.* Applicants' response is made of record) both Applicant's request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner.

23. Also in accordance with *In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35, the Examiner finds that the reference Purchasing & Supply Management, Text and Cases, 6th Ed. by Dobler et. al. ("Dobler") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The Examiner finds that Dobler describes basic supply management practices. The reference is cited in its entirety. The Examiner notes that each chapter is designed to 'stand by itself.' Because "[w]ell known text books in English are obvious research materials." *In re Howarth*, 654, F.2d 103, 210 USPQ 689, 692 (CCPA 1981), because this textbook is self described as a "basic text," because the textbook is in its 6th edition and in its forth decade of use, the Examiner finds that Dobler is obvious research material. After further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that Dobler is primarily directed towards those of low skill in this art. Because Dobler is directed towards those of low

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skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within Dobler.

24. Because this application is now final, Applicants are also reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

25. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (beginning on page 9) traversing the Examiner's positions on

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various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹¹ the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
November 25, 2005

¹¹ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.